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EXAMINER

HOLMES, JUSTIN

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVEN G. THOMAS, ANDREAS E. PERAKES,
MATTHEW D. HAMMOND, STEVEN A. FRAIT,
MONICA R. DEGRAFFENREID, GREGORY D. GOLESKI,
CHIP HARTINGER and JEFFREY E. MAURER

Appeal 2011-011710
Application 11/947,201
Technology Center 3600

Before: WILLIAM V. SAINDON, WILLIAM A. CAPP and
NEIL T. POWELL, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

Appellants' invention relates to a motor vehicle powertrain. Spec. 1.
Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A powertrain, comprising:
 - a transmission including a pump, a sump and a lube circuit;
 - a transfer case including an output driving a second pump;
 - a circuit alternately supplying the lube circuit from the pump and connecting the second pump to the sump when lube circuit pressure exceeds pressure from the second pump, and connecting the second pump to the lube circuit when lube circuit pressure is less than pressure from the second pump.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Smith	US 5,115,887	May 26, 1992
Wakahara	US 5,875,865	Mar. 2, 1999
Damm	US 6,457,564 B1	Oct. 1, 2002
Baxter	US 6,582,331 B1	Jun. 24, 2003

The following rejections are before us for review:

1. Claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite.
2. Claim 1 is rejected under 35 U.S.C. §§ 102(b) and/or 103(a) as being anticipated by or, alternatively, unpatentable over Damm.
3. Claims 1, 4, 6-8, 11, 13-17 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wakahara, Damm and Baxter.
4. Claims 2, 3, 9, 10 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wakahara, Damm, Baxter and Smith.

OPINION

Indefiniteness

The Examiner finds independent claims 1, 8 and 16 indefinite, stating that it is unclear as to what the “alternative” connection is. Ans. 3-4.

Appellants argue that claims 1, 8 and 16 are consistent with the description of the circuit in the specification. App. Br. 6, citing Spec 9, ll. 5-6; Fig. 3.

The test for definiteness under 35 U.S.C. § 112, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). Figure 3 shows a check ball valve **142** that alternately opens or closes depending on whether the pressure on one side of the ball is higher or lower than the opposite side. *See* Fig. 3. The fluid is routed from the second pump (scavenge pump **124**) to either the transmission sump **126** or the lube circuit **140** depending on which side of the check ball valve **142** has the higher pressure. *Id.* Under the circumstances, we believe that a person skilled in the pertinent would understand what is claimed in light of the specification. Accordingly, we do not sustain the rejection of claims 1-20 on the grounds of indefiniteness.

Anticipation by Damm

The Examiner finds that Damm discloses all of the limitations of claim 1. Ans. 4-5. In particular, the Examiner finds that the limitation directed to a transmission reads on engine **2** and the limitation directed to a transfer case reads on gear device **3** of Damm. Ans. 4. Appellants traverse the rejection, among other things, on the grounds that element **2** in Damm is an engine not a transmission and that Damm’s gear device **3** is not a transfer case. App. Br. 7-8. We agree.

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). However, in this case, the context of the specification is directed to a four-wheel-drive vehicle. *See* Spec. 1-4. Even under the broadest reasonable construction, we think a person of ordinary skill in the field of automotive design would differentiate between an engine and a transmission.

Similarly, the term “transfer case” appears to have a commonly understood meaning in the automotive field. *See e.g.*, Wakahara, col. 6, l. 48. Generally, a “transfer case” is a drive system component that connects the transmission to the front and rear drive shafts in a four-wheel-drive vehicle. *Id.*; Appellants’ Spec. pp. 1, 2, 3, 4. We agree that an automotive practitioner would differentiate between Damm’s gear device and a transfer case on a four-wheel-drive vehicle.

While the Examiner may be correct, in principle, that limitations from the specification are not read into the claims, claims must still be interpreted in light of the specification of which they are a part. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). Ans. 12. Here, the Examiner erred by failing to take into account the overall context of a four-wheel-drive vehicle in construing transmission and transfer case and, thus, construed the claims too broadly.

Inasmuch as we agree with the Appellants that Damm does not disclose a transmission or a transfer case, we do not sustain the anticipation rejection of claim 1.

Unpatentability of Claim 1 over Damm

The Examiner's unpatentability rejection relies on essentially the same fact findings of the Examiner's anticipation rejection over Damm. Ans. 4-5. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Damm's sumps and valves to achieve the claimed invention. Ans. 4.

Appellants traverse the rejection, among other things, on the grounds that element **32** in Damm is a one-way or check valve. App. Br. 7. Appellants argue that valve **32** opens and closes based on fluid level in the sump and not in response to pressure. *Id.*

We agree with Appellants that valve **32** in Damm responds to fluid level from level sensor **25**, not pressure. Damm, col 3, l. 55; col. 4, ll. 8-10. We also renew our disagreement with the Examiner's fact findings related to the transmission and transfer case limitations of claim 1. The Examiner's alternate rejection over Damm does not adequately explain how or why a person of ordinary skill would adapt the teachings of Damm's engine and gear device lubrication system to achieve a transmission and transfer case system as disclosed and claimed in the instant application. Accordingly, we do not sustain the unpatentability rejection of claim 1 over Damm.

*Unpatentability of Claims 1, 4, 6-8, 11, 13-17 and 19
Over Wakahara, Damm and Baxter*

Claims 1, 8 and 16

The Examiner finds that Wakahara discloses all of the limitations of claim 1, 8 and 16 except for: (1) a second pump alternately supplying fluid to the lube circuit or the sump; and (2) a transfer case that has a second pump. Ans. 6-7. The Examiner relies on Damm to supply the first missing limitation and relies on Baxter to supply the second missing limitation.

Ans. 7. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Wakahara to include the hydraulic circuitry of Damm to connect the transmission to the transfer case to provide lubrication of the transfer case gears. Ans. 7-8. The Examiner also concludes that it would have been similarly obvious to drive the transfer case pump of Wakahara with the output shaft as taught by Baxter. Ans. 8.

The Examiner's underlying rationale for rejecting these claims remains dependent, at least in part, on the Examiner's erroneous fact findings that Damm discloses a transmission and transfer case within the meaning of claims 1, 8 and 16 that we discussed previously. *See* discussion of anticipation rejection above; Ans. 6-9, 15-16. In addition, Wakahara relates to a hydraulic pressure operated transfer clutch, not a lubrication circuit. Wakahara, col. 4, ll. 1-3. The Examiner has failed to show that a person of ordinary skill in the art would adapt Wakahara's teachings of a hydraulic transfer clutch to a lubrication circuit. Neither has the Examiner shown that Wakahara and/or Baxter otherwise cure the deficiencies that we have previously noted in Damm. Moreover, taking cognizance of the fact that Damm's engine **2** is not a transmission and Damm's gear device **3** is not a transfer case, the Examiner has failed to adequately explain how or why a person of ordinary skill in the art would modify the teachings of Wakahara with those of Damm and Baxter to achieve the claimed invention.

Accordingly, we do not sustain the rejection of claims 1, 8 and 16.

Claims 4, 6, 7, 11, 13-15, 17 and 19

Claims 4, 6, 7, 11, 13-15, 17 and 19 depend directly or indirectly from either claim 1 or 8 or 16. Clms. App'x. The rejections of these claims suffer

from the same infirmities that we have previously discussed with respect to claims 1, 8 and 16. For the same reasons articulated above, we do not sustain the rejection of claims 4, 6, 7, 11, 13-15, 17 and 19.

Unpatentability of Claims 2, 3, 9, 10 and 18

Claims 2, 3, 9, 10 and 18 depend directly or indirectly from either claims 1 or 8 or 16. Clms. App'x. The Examiner relies on Smith to supply the dependent limitations of these claims. Ans. 9-10. However, the rejections of these claims suffer from the same infirmities that we have previously discussed with respect to claims 1, 8 and 16. The Examiner does not find, and neither do we, that Smith overcomes the deficiencies in the combination of the teachings of Wakahara, Damm and Baxter that we have previously noted above with respect to claims 1, 4, 6-8, 11, 13-17 and 19. Therefore, we do not sustain the rejection of claims 4, 6, 7, 11, 13-15, 17 and 19.

DECISION

The decision of the Examiner to reject claims 1-20 is REVERSED.

REVERSED

rvb